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IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD

Proceeding	91188339
Party	Plaintiff RussellG.Weiner
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1 **IN THE UNITED STATES PATENT AND TRADEMARK OFFICE**
2 **BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD**

3 Serial No. 77501585

4 Mark: DIVE BAR ROCK STAR

5 _____
6 RUSSELL G. WEINER, an individual,)

7 Opposer,)

8 v.)

9 EDWARD HOFRICHTER, an individual,)
10 and JOHN PISANO, an individual,)

11 Applicants.)
12 _____

Opposition No. 91188339

13 **OPPOSER’S OPPOSITION**
14 **TO APPLICANTS’ MOTION FOR JUDGMENT ON THE PLEADINGS**
15 _____

16 Opposer Russell G. Weiner (“Opposer”) hereby opposes the Motion for Judgment on the
17 Pleadings filed by Applicants Edward Hofrichter and John Pisano (“Applicants”).

18 Opposer is confident that he will prevail in this opposition proceeding based on likelihood of
19 confusion between his well-known ROCKSTAR marks and Applicants’ proposed DIVE BAR ROCK
20 STAR mark. Regardless, however, it would be improper to enter judgment in favor of Applicants at
21 this time. The parties have not served initial disclosures and have not taken any discovery – indeed, the
22 discovery period has not even opened yet. Applicants ask the Board to enter judgment based on the
23 pleadings alone, despite Opposers’ well-pleaded allegations of priority and likelihood of confusion
24 concerning the similar marks at issue (and such allegations are presumed to be true at this stage in the
25 proceedings). This is not allowed under the law.

26 In short, Opposer’s Notice of Opposition alleges facts that, if proved, are a sufficient basis for
27 refusing Applicants’ registration. Therefore, the Board should deny Applicants’ Motion for Judgment
28 on the Pleadings.

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1 of Opposition, Opposer will be damaged by registration of Applicant's proposed mark, and the Board
2 should refuse registration under Section 2(d).

3 Determining likelihood of confusion ultimately involves consideration of thirteen factors:

- 4 (1) The similarity or dissimilarity of the marks in their entireties as to appearance, sound,
5 connotation and commercial impression.
- 6 (2) The similarity or dissimilarity and nature of the goods or services as described in an
7 application or registration or in connection with which a prior mark is in use.
- 8 (3) The similarity or dissimilarity of established, likely-to-continue trade channels.
- 9 (4) The conditions under which and buyers to whom sales are made, i.e. "impulse" vs.
10 careful, sophisticated purchasing.
- 11 (5) The fame of the prior mark (sales, advertising, length of use).
- 12 (6) The number and nature of similar marks in use on similar goods.
- 13 (7) The nature and extent of any actual confusion.
- 14 (8) The length of time during and conditions under which there has been concurrent use
15 without evidence of actual confusion.
- 16 (9) The variety of goods on which a mark is or is not used (house mark, "family" mark,
17 product mark).
- 18 (10) The market interface between applicant and the owner of a prior mark:
 - 19 (a) a mere "consent" to register or use.
 - 20 (b) agreement provisions designed to preclude confusion, i.e. limitations on
21 continued use of the marks by each party.
 - 22 (c) assignment of mark, application, registration and good will of the related
23 business.
 - 24 (d) laches and estoppel attributable to owner of prior mark and indicative of lack of
25 confusion.
- 26 (11) The extent to which applicant has a right to exclude others from use of its mark on its
27 goods.
- 28 (12) The extent of potential confusion, i.e., whether de minimis or substantial.
- (13) Any other established fact probative of the effect of use.

26 *In re E. I. Du Pont de Nemours & Co.*, 476 F.2d 1357, 1361 (CCPA 1973). See TBMP §
27 309.03(c)(B) ("The evidentiary factors the Board considers in determining likelihood of confusion
28

1 are set out in [*Du Pont*]. ... The relevance and weight to be given the various factors may differ
2 from case to case.”).

3 Clearly the Board cannot properly analyze all (if any) of the above *Du Pont* factors based only
4 on the allegations in the pleadings.

5 Insofar as the pleadings shed light on a few of the *Du Pont* factors, these factors appear to
6 support a finding of likelihood of confusion. For example, the marks at issue – Opposer’s ROCKSTAR
7 and ROCKSTAR composite marks on the one hand, and Applicant’s proposed DIVE BAR ROCK
8 STAR mark on the other – contain the same dominant elements, and are substantially similar.
9 Furthermore, the goods identified in Applicants’ application, which include beverage glassware, mugs,
10 and coasters, are related to Opposer’s goods. That being said, the pleadings simply do not address
11 many key *Du Pont* factors, such as the relevant purchasers and the fame of the prior mark, which weigh
12 strongly in favor of Opposer. *See Recot, Inc. v. Becton*, 214 F.3d 1322, 1327 (Fed. Cir. 2000) (“The
13 fifth *DuPont* factor, fame of the prior mark, when present, plays a ‘dominant’ role in the process of
14 balancing the *DuPont* factors.”).¹

15 Applicants do not cite any cases in which the Board granted a motion for judgment on the
16 pleadings in the face of an opposer’s well-pleaded allegations of priority and likelihood of confusion.
17 Indeed, where an applicant is so brazen as to file a motion for judgment on the pleadings under these
18 circumstances, the Board routinely denies such a motion. *See, e.g., T.M. Pacific Co., Ltd. v. The Body*
19 *Shop International, PLC*, 1998 TTAB LEXIS 431, at *6-7 (TTAB 1998); *Chatam International Inc.*
20 *v. Abita Brewing Company, Inc.*, 49 USPQ2d 2021, 1998 TTAB LEXIS 527, at *6 (TTAB 1998);
21 *Creo Products Inc. v. Martin-Williams, Inc.*, 2002 TTAB LEXIS 560, at *6-7 (TTAB 2002) (non-
22 precedential) (rejecting opposer’s argument that “a single factor can outweigh all others and be
23 dispositive of the issue of likelihood of confusion” for purposes of a motion for judgment on the
24 pleadings).

25
26 ¹ Opposer’s ROCKSTAR energy drinks are among the most popular in the world. Opposer’s
27 licensees have sold over one billion cans of product and annually have sales of several hundred
28 million dollars.

Applicants' reliance on *In re Coca-Cola*, Serial No. 78449413 (Oct. 29, 2006) – an *ex parte* appeal – reflects Applicants' misunderstanding of the applicable standard. In fact, after the Board's ruling in *Coca-Cola*, applicant's proposed mark SPRITE QUENCH was published for opposition, and the owner of the registered mark QUENCH opposed. That opposition proceeding (Opp. No. 91185243) is currently pending.²

CONCLUSION

Applicants seek to end this proceeding before it truly begins. For the reasons discussed above, the Board should deny Applicants' Motion for Judgment on the Pleadings and allow Opposer to wage its opposition.

Dated: March 17, 2009

Respectfully submitted,

HARVEY SISKIND LLP

/s/

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² In any event, the Board's analysis in *Coca-Cola* supports a finding of likelihood of confusion here. The Board explained: "Generally, when a mark of one party completely encompasses that of another on related or identical goods there will be likelihood of confusion, particularly where the matter added to one of the marks is descriptive or highly suggestive." Here, the only meaningful difference between the parties' marks is Applicant's inclusion of the term "DIVE BAR," which Applicant *concedes* "refers to and specifically connotes" an aspect of Applicant's products. (In *Coca-Cola*, the Board's decision to allow applicant's SPRITE QUENCH mark to be published for opposition turned largely on the inclusion of the "arbitrary mark" SPRITE.)

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Seth I. Appel

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/s/
Seth I. Appel